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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,831	06/05/2006	Syuji Ichimura	06061/HG	8246
1933 7590 07/30/2009 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER KOKKINOS, NICHOLAS C				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,831

Applicant(s)

ICHIMURA ET AL.

Examiner

NICHOLAS KOKKINOS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in a prior Office Action.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The list of documents on pages 37 and 38 of the remarks filed on 6 April 2009 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The documents and listing have been placed in the application file, but the information referred to therein has not been considered.
4. Applicant is also advised that per 37 CFR 1.98(a)(2)(ii), the submission of copies of published U.S. Patents is not required.

Claim Rejections - 35 USC § 103

5. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication 2000-160121 to Kitayama et al. in view of Japanese Patent Application Publication H09-176581 to Ooshima et al. English human translations are relied upon.

6. Regarding claims 1-4, 6, and 7, the rejections of the previous office action, dated 7 January 2009, are hereby incorporated by reference.

7. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication 2000-160121 to Kitayama et al. in view of Japanese Patent Application Publication H09-176581 to Ooshima et al., and further in view of European Patent Publication EP0955346 to Ichimura et al. English human translations are relied upon for the Japanese documents.

8. Regarding claims 5-8, the rejections of the previous office action, dated 7 January 2009, are hereby incorporated by reference.

Response to Arguments

9. The objection to the specification in regards to the capitalization and accompaniment of trademarks has been addressed and is hereby withdrawn.

10. The objection to the abstract has been properly addressed and is hereby withdrawn.

11. The rejection of claim 7 under 35 U.S.C. 112, second paragraph has been withdrawn in light of the currently amended claims.

12. Applicant's arguments filed 6 April 2009 in response to the office action mailed 7 January 2009 have been fully considered but they are not persuasive.

13. Applicant discusses on page 32 of the remarks the content of an enclosed English-language translation of Table 1 of JP 2000-160121; in particular, it is clear that the adhesive embodiment in Table 1 is indeed SEPTON 2063. However, this argument does not address the present rejection of claims 1 and 2 over the subject matter disclosed in paragraph [0007] of Kitayama et al., which teaches the claimed styrene isobutylene block copolymer. The assertion that the specific disclosed embodiments of the prior art does not teach the instantly claimed composition cannot overcome a finding that the prior art nevertheless provides an enabling disclosure of the instantly claimed invention. The courts have also held that, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

14. Applicant also discusses on pages 32 and 33 of the remarks that while Kitayama discloses (*paragraph [0007]*) an aromatic vinyl compound and isobutylene as a styrene system block copolymer, this does not concretely or specifically disclose a styrene isobutylene block copolymer as recited in the claims. However, as outlined in the rejection from the previous office action, Kitayama (*paragraph [0007]*) does render the present invention obvious in view of the teachings of Ooshima.

15. Further, it is noted that Kitayama only discusses SEPTON 2063 as being "the hydrogenated product of a block copolymer of styrene and isoprene" (*page 15, examiner's submitted human translation*) or "a hydrogen additive of a block copolymer consisting of styrene and isoprene" (*Appendix 13, applicant's submitted Table 1 translation*). Both of these disclosures allude to SEPTON 2063 being a copolymer of styrene and isoprene, but nothing can be gathered beyond that. Although applicant's submission has been considered, it contrasts with the fact that trademarks are used to denote the *source* of goods, not the goods themselves. While it may be true that SEPTON 2063 is a styrene-ethylene-propylene-styrene copolymer, it is known that trade products are often altered and improved, and that formulations are frequently subject to change to facilitate such improvements.

16. Because the prior art discloses the same material composition as that instantly claimed, it follows that it would also possess the same advantageous properties related to high-speed peel strength as applicant discusses on pages 33 and 34 of the remarks. It should be noted, however, that whether one of ordinary skill in the art would expect to obtain the exact properties in the tests proposed by applicant is immaterial, because "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant." See MPEP § 2144, (*IV. Rationale Different From Applicant's Is Permissible*), e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293,

1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

17. Even further, per MPEP § 2112 (*I. Something Which Is Old Does Not Become Patentable Upon The Dis-Coverly Of A New Property*), "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ 2d 1943, 1947 (Fed. Cir. 1999).

18. However, it may also be inferred that applicant's discussion of high speed peel strength (*pages 33-35 of the remarks*) are directed at establishing comparative data for the purpose of showing unexpected results over the prior art. Applicants argue that a surface protective sheet comprising the styrene-isobutylene block copolymer as instantly claimed (*examples 1-6*) is superior in high speed peel strength as compared to a surface protective sheet comprising SEPS (*comparative example 1*) or SIS (*comparative example 7*). However, it is noted that there is only a proper side-by-side comparison between comparative example 1 and example 1, and comparative example 7 and example 3. Secondly, the data is not commensurate with the scope of the instant claims given that there is only one amount of the softening agent, and one amount of the tackifying resin. Per MPEP § 716.02(d), whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, "objective

evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to determine if the results occurred over the entire claimed range. See *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Applicants have not provided data to show that the unexpected results do in fact occur over the entire claimed ranges of softening agent and tackifying resin. Further, the data is not commensurate in scope with claim 1's broad recitation of "a softening agent" and "a tackifying resin."

19. For the above reasons, the grounds of rejection under 35 U.S.C. 103 presented in the previous action have been reapplied.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS KOKKINOS whose telephone number is (571) 270-7384. The examiner can normally be reached on Monday-Thursday 9am-5pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NK/
21 July 2009

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794